

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 12 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

#### REMARKS/ARGUMENTS

Claims 1-111 were in the application as filed. Claims 55-85 were subject to restriction and have been cancelled without prejudice. 1-54 and 86-111 stand rejected. The Examiner has indicated that claim 104 would be allowable if rewritten to include the limitations of the rejected base claim and any intervening claims. Claim 1 has been amended in this paper to correct a typographic error.

No new matter has been added by the foregoing amendments, full support therefor being shown in the drawings and specification as filed. All claims remaining in the application are believed to now be in condition for allowance.

Further examination and reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### Claim Rejections - 35 U.S.C. §102(b)

Claims 1-24, 85-90, 100-102, and 105-111 stand rejected under 35 U.S.C. §102(b), as allegedly anticipated by U.S. Patent No. 5,209,030 to Sloditskie et al. The rejection is respectfully traversed.

The claimed invention is not anticipated under §102 unless each and every element of the claimed invention is found in the prior art. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). To anticipate, a single reference must teach each and every limitation of the claimed invention. *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1335; 73 U.S.P.Q.2D (BNA) 1782 (Fed. Cir. 2005). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 85 has been cancelled without prejudice pursuant to a restriction requirement. Applicant assumes that the Examiner meant the rejection to apply to claim 86 rather than claim 85.

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 13 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

Claim 1 calls for a roof dormer comprising a girder frame having a pair of elongated rails, a front frame mounted to the girder frame, and a top frame mounted to the front frame. The girder frame is configured to be in register with an opening in an angled roof portion of the structure when the girder frame is mounted to the roof portion of a structure. The front frame is configured to be positioned in a generally vertical orientation when the girder frame is mounted to the roof portion. The top frame is configured to form a roof for the dormer. At least two of the girder frame, the front frame, and the top frame are pivotally mounted to one another between a first, lowered position and a second, finished position. Claims 2-24 depend from claim 1.

Claim 86 calls for an erectable dormer assembly for attachment to a roof portion of a structure comprising a girder frame, a front frame, and a top frame. The girder frame is adapted to be interconnected to the roof portion of the structure. The front frame is interconnected to the girder frame and adapted to form a visible vertical wall of the dormer assembly. The top frame is interconnected to the girder frame and adapted to form a roof portion of the dormer assembly. At least one of the front frame and the top frame are pivotally interconnected to the girder frame between a first, lowered position and a second, finished position to assist in the easy transportation and erection of the dormer assembly. Claims 87-90, 100-102, and 105-111 depend from claim 86.

Sloditskie '030 discloses a structure intended to be erected upon a one-story base unit and to serve as a second story. Sloditskie '030 does not disclose a dormer, although Sloditskie '030 refers to a combined vertical wall and roof structure as a dormer. A dormer is defined as "A projecting vertical window in the sloping roof of a house." *The Oxford English Dictionary, 2nd Ed., Clarendon Press (1991)*. Sloditskie '030 also does not disclose a girder frame, or a girder frame configured to be in register with an opening in an angled roof portion of a structure, or a front frame connected to a girder frame, or a girder frame, a front frame, or a top frame pivotally interconnected.

The dormer-like structure 12 disclosed in Sloditskie '030 comprises a vertical side wall 22 and a roof structure 20. The side wall 22 is pivotally attached to the base unit 14 so that the side

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 14 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

wall 22 can be tilted from a lowered, horizontal orientation on the base unit 14 to a vertical position along an outer edge of the base unit 14 to form a second-story wall extending the length of the base unit 14 (*See, col. 3, ln. 51-54*). The roof structure 20 rests on the side wall 22 and is connected to an angled roof structure 16 along a ridge line. The angled roof structure 16 is pivotally attached to a plurality of gussets 36 attached to ceiling joists 38 of the base unit 18. No pivotal connections tie the roof structure 20 or the side wall 22 to the angled roof structure 16.

When completed, the vertical side wall 22, roof structure 20, and angled roof structure 16 form a conventional second story having a vertical wall and a pitched roof extending the length of the building. *See, Sloditskie '030, Fig. 5*. Sloditskie '030 states unequivocally that "The dormer of the present invention is to be distinguished from a dormer window unit which typically includes only a gabled window frame that projects from an angled roof. In the present invention, the dormer unit is contemplated to form a second story room or major portion thereof defining an area below the roof 20 and the angled roof structure 16." *Col. 2, ln. 41-47*. Furthermore, the angled roof structure 16 forms no part of the dormer. "However, the assembly method for angled roofing structure 16 as shown does not form a part of the present invention other than its contribution to forming the second story room along with the collapsible dormer 12." *Col. 2, ln. 64-68*.

Both claim 1 and claim 86 require a dormer. The second-story structure described in Sloditskie '030 is not a dormer according to the dictionary definition. Furthermore, the term "dormer" as used by Applicant in the specification is consistent with the dictionary definition, and distinguishable from the structure referred to in Sloditskie '030 as a "dormer."

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 15 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

### Claims 1-24

Claim 1 requires a girder frame mounted to the roof portion of a structure. Thus, the girder frame must be a frame, not a single member, and it must be attached to a roof portion. The only elements in Sloditskie '030 that comprise a frame attached to a roof portion are the vertical side wall 22, the side wall 42, and the side wall portion 54. However, the girder frame must also be in register with an opening in an angled roof portion of the structure when the girder frame is mounted to the roof portion. There is no opening in either the roof structure 20 or the angled roof structure 16. Furthermore, neither the side wall 22, the side wall 42, nor the side wall portion 54 are in register with an opening in either the roof structure 20 or the angled roof structure 16 when these wall frames 22, 42, 54 are mounted to the roof structure 20 and the angled roof structure 16.

Claim 1 also requires a front frame configured to be positioned in a generally vertical orientation when the girder frame is mounted to the roof portion. The only vertical front frame disclosed in Sloditskie '030 is the side wall 22. Thus, for this reason as well, the side wall 22 cannot be the girder frame. The side wall 22 could only be considered the front frame as it is the only vertical structure that can be accurately described by the term "front."

Only the roof structure 20 or the angled roof structure 16 could comprise the top frame called for in claim 1 because the top frame must be configured to form a roof for the dormer, and the roof structure 20 and angled roof structure 16 form the roof. However, the top frame must be mounted to the front frame. Because the angled roof structure 16 is not mounted to the side wall 22, it cannot be the top frame.

Finally, at least two of the girder frame, the front frame, and the top frame must be pivotally mounted to one another between a first, lowered position and a second, finished position. As discussed above, Sloditskie '030 does not disclose a girder frame. Consequently, it is the front frame and the top frame that must be pivotally mounted to one another, which in Sloditskie '030 are the side wall 22 and the roof structure 20. However, the side wall 22 is not

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 16 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

pivots to the roof structure 20. The side wall 22 is pivotally mounted only to the base unit 14, which in no way can be considered the top frame. Furthermore, the pivotal mounting of the front frame to the top frame relates to the erection of the dormer from a first, lowered position to a second, finished position. This also is not disclosed in Sloditskie '030. In assembling the second-story structure of Sloditskie '030, the roof structure 20 is completely disattached from the side wall 22 and later reattached to the side wall 22 by lifting and lowering the roof structure 20 onto the already raised side wall 22.

Because each and every element of the invention of claim 1 is not found in Sloditskie '030 in as complete detail as is contained in claim 1, claim 1 is not anticipated by Sloditskie '030. Because claims 2-24 depend from claim 1, they are for the same reasons not anticipated by Sloditskie '030. Applicant requests the withdrawal of the rejection of claims 1-24, and the allowance of claims 1-24.

#### Claims 86-90, 100-102, and 105-111

Claim 86 calls for a girder frame adapted to be interconnected to a roof portion of a structure. As discussed above, the only elements in Sloditskie '030 that comprise a frame attached to a roof portion are the side wall 22, the side wall 42, and the side wall portion 54. Claim 86 also calls for a front frame forming a visible vertical wall and interconnected to the girder frame. As discussed above, only the side wall 22 would comprise a front frame. Thus, if the side wall 22 were to comprise a front frame, only the side wall 42 or the side wall portion 54 could comprise a girder frame.

Claim 86 also requires a top frame configured to form a roof and interconnected to the girder frame. As discussed above, the roof structure 20 could only be the top frame. Consequently, only the side wall portion 54 could comprise the girder frame because it is the only one of the two frames 42, 54 that is interconnected to the roof structure 20.

Finally, claim 86 requires that at least one of the front frame and the top frame be pivotally interconnected to the girder frame. However, neither the side wall 22 nor the roof

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 17 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

structure 20 is pivotally interconnected to the side wall portion 54. As discussed above, the side wall 22 is pivotally connected only to the base unit 14, which in no way can be construed as comprising the girder frame. Furthermore, the roof structure 20 is not pivotally interconnected with any other frame in Sloditskie '030. Thus, each and every element of the invention of claim 86 is not found in Sloditskie '030 in as complete detail as is contained in claim 86, and claim 86 is not anticipated by Sloditskie '030.

Because claims 87-90, 100-102, and 105-111 depend from claim 86, they are for the same reasons not anticipated by Sloditskie '030. Applicant requests the withdrawal of the rejection of claims 86-90, 100-102, and 105-111, and the allowance of claims 86-90, 100-102, and 105-111.

#### Claim Rejections - 35 U.S.C. §103(a)

##### Claim 1

Claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over French Patent No. 2,674,273 to Mallie in view of Sloditskie '030. The rejection is respectfully traversed.

A claimed invention is unpatentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art....The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact.<sup>1</sup>

---

<sup>1</sup> The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 15 L. Ed. 2d 545, 86 S. Ct. 684 (1966).

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 18 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field....Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

Most if not all inventions arise from a combination of old elements....Thus, every element of a claimed invention may often be found in the prior art....However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention....Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant....Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved....In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 19 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

art....Whether the Patent Office Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto....Broad conclusory statements standing alone are not "evidence."

*In Re Werner Kotzab*, 217 F.3d 1365; 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000)(citations omitted).

The Examiner has failed to identify any motivation, suggestion, or teaching of the desirability of combining Mallie '273 and Sloditskie '030 to arrive at Applicant's invention. There has been no statement identified in the prior art, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the combined teachings, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for an implicit showing of motivation. The Examiner has failed to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Mallie '273 and Sloditskie '030. Rather, the Examiner has simply relied upon "broad conclusory statements standing alone." *Id.* The rejection of claim 1 is improper and should be withdrawn.

As discussed *supra*, Sloditskie '030 does not disclose the pivotal attachment of at least two of the girder frame, the front frame, and the top frame. Mallie '273 discloses what appears to be a conventional dormer structure. However, Mallie 273 does not disclose the pivotal inter-attachment of any of the girder frame, the front frame, or the top frame. Thus, even if the combination of Mallie '273 and Sloditskie '030 were proper, the combination of Mallie '273 and Sloditskie '030 fails to disclose the invention of claim 1.

Claim 1 is not unpatentable over Mallie '273 in view of Sloditskie '030. Applicant requests the withdrawal of the rejection of claim 1, and the allowance of claim 1.

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 20 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

**Claims 25-54, 91-99, and 103**

Claims 25-54, 91-99, and 103 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Sloditskie '030 in view of U.S. Patent No. 5,094,059 to Ganescu. The rejection is respectfully traversed.

Claim 25 calls for a dormer and a hinge attached to the dormer for pivotally mounting the dormer to the roof portion of a structure between a collapsed position and a finished, erected position.

Ganescu '059 discloses a roof truss 2 having an inclined top chord 6 which is hingedly attached to a truss bottom chord 4. The top chord 6 can be pivoted from a folded position against the bottom chord 4 to an unfolded position inclined away from the bottom chord. A knee wall 10 is hingedly attached to the inclined top chord 6 and pivots orthogonally to the top chord 6 for support of the top chord 6 when the truss 2 is erected.

Only the structural members of the truss are hinged. No part of the truss is hingedly connected to a member or structure external of the truss.

The Examiner has failed to identify any motivation, suggestion, or teaching of the desirability of combining Sloditskie '030 and Ganescu '059 to arrive at Applicant's invention. There has been no statement identified in the prior art, there has been no discussion of the knowledge of one of ordinary skill in the art or the nature of the problem to be solved, there has been no identification of what the combined teachings, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to one of ordinary skill in the art as required for an implicit showing of motivation. The Examiner has failed to provide any particular findings related to any motivation, suggestion, or teaching of the desirability of combining Sloditskie '030 and Ganescu '059. Rather, the Examiner has simply relied upon "broad conclusory statements standing alone." The rejection of claims 25-54, 91-99, and 103 is improper and should be withdrawn.

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 21 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

Neither Sloditskie '030 nor Ganescu '059 discloses a dormer as called for in claim 25. Furthermore, neither Sloditskie '030 nor Ganescu '059 discloses a hinge attached to a dormer, nor pivotally mounting a dormer to the roof portion of a structure between a collapsed position and a finished, erected position. At most, the combination of Sloditskie '030 and Ganescu '059 discloses a vertical side wall, a roof structure, and an angled roof structure forming a conventional second story having a vertical wall and a pitched roof extending the length of the building, with a roof truss having members hingedly attached to each other to enable the truss to assume uncollapsed and collapsed configurations. This is not the invention of claim 25. Thus, even if the combination of Sloditskie '030 and Ganescu '059 were proper, the combination of Sloditskie '030 and Ganescu '059 fails to disclose the invention of claim 25.

Claim 25 is not unpatentable over Sloditskie '030 in view of Ganescu '059. Because claims 26-54 depend from claim 25, they are for the same reasons not unpatentable over Sloditskie '030 in view of Ganescu '059. Applicant requests the withdrawal of the rejection of claims 25-54, and the allowance of claims 25-54.

Claims 91-99 and 103 depend from claim 86. As discussed, *supra*, claim 86 calls for a girder frame, which is not disclosed in Sloditskie '030. Ganescu '059 also does not disclose a girder frame. Thus, the combination of Sloditskie '030 and Ganescu '059 cannot disclose a girder frame. Furthermore, as discussed, *supra*, the combination of Sloditskie '030 and Ganescu '059 discloses a vertical side wall, a roof structure, and an angled roof structure forming a conventional second story having a vertical wall and a pitched roof extending the length of the building, with a roof truss having members hingedly attached to each other to enable the truss to assume uncollapsed and collapsed configurations. This is not the invention of claim 86.

Because claims 91-99 and 103 depend from claim 86, they are for the same reasons not unpatentable over Sloditskie '030 in view of Ganescu '059. Applicant requests the withdrawal of the rejection of claims 91-99 and 103, and the allowance of claims 91-99 and 103.

Serial No. 10/604,433  
Filed: 07/21/2003  
Page 22 of 22

Examiner: Jeanette E. Chapman  
Group Art Unit: 3635

## CONCLUSION

For the reasons discussed above, all claims remaining in the application are allowable over the prior art. Early notification of allowability is respectfully requested.

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

BRIAN K. ELLENBERGER

Dated: November 4, 2005

By:   
G. Thomas Williams, Reg. No. 42,228  
McGarry Bair PC  
171 Monroe Avenue, N.W., Suite 600  
Grand Rapids, Michigan 49503  
(616) 742-3500

G0194569.DOC